

Notice of Allowability

Application No.

10/763,037

Examiner

SCOTT LONG

Applicant(s)

SCHWARTZ ET AL.

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/7/2009.
2. ☒ The allowed claim(s) is/are 5,6 and 8-15.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>20090612</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

/Janet L. Epps-Smith/
Primary Examiner, Art Unit 1633

DETAILED ACTION

The examiner acknowledges receipt of Applicant's, filed on 7 May 2009.

Priority

This application claims benefit from provisional U.S. Application No. 60/441,668 (filed 01/22/2003). The instant application has been granted the benefit date, 22 January 2003, from the application 60/441,668.

RESPONSE TO ARGUMENTS

35 USC § 1103

The rejection of claims 5-6 and 8-15 under 35 U.S.C. 103(a) as being unpatentable over Drewett et al. (Journal of Biological Chemistry. 2001. Vol.276; No.36: 33444-33451) in view of Narula et al. (PNAS. July 1999. Col.96: 8144-8149) is withdrawn in response to the applicant's arguments and/or claim amendments.

The applicant's arguments have been fully considered and are persuasive. The applicant has presented several arguments directed to the following points: (1) heart failure does not always involve apoptosis, (2) caspase-3 is not always associated with SRF or heart disease, and (3) SRF is not always associated with apoptosis. A critical part of the examiner's obviousness rejection was establishing the link between SRF cleavage and heart disease. The examiner was not able to find a reference which directly made this connection, so the rejection attempted to establish this link by

Art Unit: 1633

showing (1) a connection between cardiac disease and apoptosis and (2) a connection between apoptosis and SRF cleavage. The applicant has presented sufficient documentation in the form of the following references to show that the nexus between SRF cleavage and heart disease was not well established at the time of filing the instant application:

Kang et al. (Circulation Research. 2000; 86: 1107-1113)

Cohen (Biochemical Journal. 1997; 326: 1-15)

Therefore, the examiner finds the applicant's arguments persuasive.

Accordingly, the examiner hereby withdraws the rejection of claims 5-6 and 8-15 under 35 U.S.C. 103(a) as being unpatentable over Drewett et al. in view of Narula et al.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance:

The prosecution history provides evidence for allowability.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The examiner notified T. Ling Chwang of the proposed Examiner's Amendment on 6/18//2009.

The claims have been amended as follows:

Claim 5. A method of diagnosing cardiac disease resulting from apoptosis in an individual, comprising the step of identifying cleavage of SRF in at least one cardiac cell from a sample from said individual, wherein identifying said SRF cleavage fragment indicates a diagnosis of cardiac disease resulting from apoptosis.

Conclusion

Claims 5-6 and 8-15 are allowed.

Examiner Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Scott Long** whose telephone number is **571-272-9048**. The examiner can normally be reached on Monday - Friday, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph Weitach** can be reached on **571-272-0739**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SDL/ Scott Long
Patent Examiner, Art Unit 1633

/Janet L. Epps-Smith/
Primary Examiner, Art Unit 1633